



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,613	07/18/2002	Oystein Rekdal	1181-258	3472

6449 7590 04/15/2004

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

DESAI, ANAND U

ART UNIT PAPER NUMBER

1653

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/069,613	Applicant(s) REKDAL ET AL.	
	Examiner Anand U Desai, Ph.D.	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, 11 in part, 16, 18, drawn to a method of producing a bioactive peptide, a peptide produced by the method, and a method of treating benign or malignant tumors administering a bioactive peptide.

Group II, claim(s) 6, and 11 in part, drawn to a method of producing a bioactive peptide that contains no more than 1 bulky and lipophilic amino acid in a sector opposite a cationic sector.

Group III, claim(s) 7-10, and 11 in part, drawn to a method of producing a distinct bioactive peptide.

Group IV, claim(s) 12, 14, and 22 in part, drawn to a cytotoxic 12 to 25 amino acid peptide.

Group V, claim(s) 13, 14, and 22 in part, drawn to a cytotoxic 12 to 25 amino acid peptide which comprises at least 7 cationic residues.

Group VI, claim(s) 19, drawn to a pharmaceutical composition comprising a peptide.

Group VII, claim(s) 20, drawn to a method of producing a pharmaceutical composition.

Group VIII, claim(s) 21, drawn to a method of preparing an antibacterial or anti-tumoral agent.

Group IX, claim(s) 23, drawn to a method of producing a biomimetic organic compound.

2. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature linking Groups I-IX appears to be that they all relate to a bioactive peptide. However, Groups I-III, and VII-IX are drawn to different methods. The multiple methods are impermissible as PCT Rules 13.1-13.2 do not allow for multiple methods. Groups IV-VI are drawn to different structures with different functions. Further, bioactive peptides are known in the art (WO 98/33509). Therefore, the technical feature linking the inventions of Groups I-IX does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be a method of producing a bioactive peptide, a peptide produced by the method, and a method of treating benign or malignant tumors administering a bioactive peptide.

The special technical feature of Group II is a method of producing a bioactive peptide that contains no more than 1 bulky and lipophilic amino acid in a sector opposite a cationic sector.

The special technical feature of Group III is a method of producing a distinct bioactive peptide as claimed.

The special technical feature of Group IV is a cytotoxic 12 to 25 amino acid peptide.

The special technical feature of Group V is a cytotoxic 12 to 25 amino acid peptide which comprises at least 7 cationic residues.

The special technical feature of Group VI is a pharmaceutical composition comprising a peptide.

The special technical feature of Group VII is a method of producing a pharmaceutical composition.

Art Unit: 1653

The special technical feature of Group VIII is a method of preparing an antibacterial or anti-tumoral agent.

The special technical feature of Group IX is a method of producing a biomimetic organic compound.

Accordingly, Groups I-IX are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

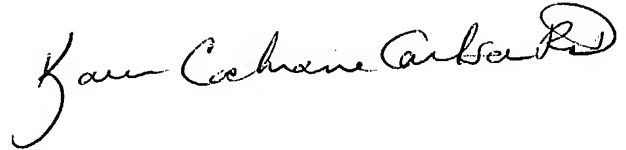
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand U Desai, Ph.D. whose telephone number is (571) 272-0947. The examiner can normally be reached on Monday - Friday 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (517) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 9, 2004

A handwritten signature in black ink, appearing to be 'AD' or similar initials, written in a cursive style.A handwritten signature in black ink, reading 'Karen Cochrane Carlson' followed by a stylized 'PhD'.

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER